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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,858	06/27/2003	Alan Michael Jaffee	7304	7146

7590

08/15/2005

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EXAMINER

BOYD, JENNIFER A

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/607,858

Applicant(s)

JAFFEE, ALAN MICHAEL

Examiner

Jennifer A. Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27, 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Applicant's Amendments and Accompanying Remarks, filed June 3, 2005, have been entered and have been carefully considered. Claims 1- 8, 22, 29 – 30 and 32 are amended, claim 28 is withdrawn and claims 1 – 27 and 29 – 32 are pending. In view of Applicant's amendments, the Examiner withdraws the 35 USC 112, second paragraph rejection as detailed in the Office Action dated December 27, 2004. The invention as currently claimed is unpatentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 16 recites that the fibrous mat further comprises "effective amounts" of fine particles of limestone, etc. What constitutes "effective amounts"? The Examiner cannot compare the claim to prior art because it is unknown what amounts would be considered "effective amounts". For the purposes of examination at this time, the Examiner will assume the presence of any amount of the listed substances would constitute an "effective amount".

***Claim Rejections - 35 USC § 102***

6. Claims 1 – 3, 7 – 15, 17 – 18, 21 – 24, 27, 29 and 32 remain rejected under 35 U.S.C. 102(b) as being anticipated by Jaffee (US 5,772,846). The details of the rejection can be found in paragraph 10 of the Office Action dated December 27, 2005. The rejection is maintained.

7. Claims 1, 16 and 25 remain rejected under 35 U.S.C. 102(b) as being anticipated by Kennedy et al. (US 5,308,692). The details of the rejection can be found in paragraph 11 of the Office Action dated December 27, 2004. The rejection is maintained.

***Claim Rejections - 35 USC § 102/103***

8. Claims 26 and 31 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jaffee (US 5,772,846). The details of the rejection can be found in paragraph 13 of the Office Action dated December 27, 2004. The rejection is maintained.

***Claim Rejections - 35 USC § 103***

9. Claims 4 – 6, 19 and 30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffee (US 5,772,846). The details of the rejection can be found in paragraph 14 of the Office Action dated December 27, 2004. The rejection is maintained.

10. Claim 20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffee (US 5,772,846) in view of Horner, Jr. et al. (US 6,365,533). The details of the rejection can be found in paragraph 15 of the Office Action dated December 27, 2004. The rejection is maintained.

***Response to Arguments***

11. Applicant's arguments filed June 3, 2005 have been fully considered but they are not persuasive.

In response to Applicant's argument the limitations of claim 16 reciting "an effective amount" does not violate the requirements of 35 USC 112, 2<sup>nd</sup> paragraph, the Examiner respectfully argues the contrary. The phrase "an effective amount" does not provide any quantitative value for comparison to the prior art thereby making the limitation indefinite. Applicant indicates that in light of the specification's requirements that the amount of biocide present in the mat must resist fungal growth as delineated by ASTM Standard D3274. The Office is not equipped to perform experiments to determine whether the prior art would meet the ASTM Standard D3274 thus implying that the biocide is present in "an effective amount" as required by Applicant. Furthermore, the Applicant relies on limitations that are not claimed (e.g. resisting fungal growth as delineated by ASTM Standard D3274). The 35 USC 112, 2<sup>nd</sup> paragraph rejection of claim 16 is maintained.

Applicant argues that Jaffee does not teach with specificity an average fiber diameter range from about 9.5 to 12.5 microns. As discussed in the rejection, Jaffee teaches that the mat comprises a major portion of textile glass fibers and a minor portion of polymer fibers (column 2, lines 50 – 60). Jaffee teaches that the glass fibers have an average diameter from about 9 microns to 20 microns (column 3, lines 35 – 40). The Examiner acknowledges that Jaffee does

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teach preferred embodiments where the fiber diameters are between 10 – 16 microns and instances where the diameter is 13, 15 and 16 microns. However, it should be noted that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Furthermore, although Jaffee does not teach with certain specificity of Applicant's desired range, it should be noted that Jaffe's range does overlap with Applicant's range. Applicant argues that the diameter range from 9.5 to 12.5 has unexpected results but has failed to provide evidence. If the claimed ranges have unexpected results, the burden is upon the Applicant to demonstrate that the claimed ranges are not a matter of simple optimization. The Examiner highly suggests to the Applicant to submit a 37 CFR 1.132 Declaration to establish unexpected results. In the Declaration, the Applicant should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960) and must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. The rejection is maintained.

In response to Applicant's comments regarding the glass transition temperature range required by Applicant, the Examiner acknowledges and apologizes for the error. However, Jaffee still discloses a range for the glass transition temperature which overlaps with the range of Jaffee. The rejection is maintained.

In response to Applicant's arguments that the limitation of "hydraulic set" should be given full patentable weight, the Examiner agrees. As discussed by Applicant in the arguments, a "hydraulic set" material encompasses gypsum. Jaffee and Kennedy are both

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directed to mats for covering gypsum boards (see Jaffee, Title and Kennedy, column 1, lines 10 – 15).

Applicant argues that Kennedy does not teach with certain specificity an average fiber diameter range of about 9.5 – 12.5 microns. As discussed in the rejection, As to claim 1, Kennedy teaches that the fire resistant mat comprises a blended web of mineral wool fibers and monofilament glass fibers wherein the fibers are bonded by a heat settable fire resistant binder (column 3, lines 64 – 69). Kennedy teaches that the glass fibers used in the mat have a diameter from between 10 and 20 microns and have a length of about 1.2 – 4.4 (column 4, lines 43 – 50). The Examiner acknowledges that Kennedy does teach preferred embodiments where the fiber diameter is 15. However, it should be noted that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Furthermore, although Kennedy does not teach with certain specificity of Applicant's desired range, it should be noted that Jaffe's range does overlap with Applicant's range. Applicant argues that the diameter range from 9.5 to 12.5 has unexpected results but has failed to provide evidence. If the claimed ranges have unexpected results, the burden is upon the Applicant to demonstrate that the claimed ranges are not a matter of simple optimization. The Examiner highly suggests to the Applicant to submit a 37 CFR 1.132 Declaration to establish unexpected results. In the Declaration, the Applicant should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960) and must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. The rejection is maintained.

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Applicant argues that Kennedy employs a blend of fibers and not fibers having a relatively restricted range of diameters of 9.5 to 12.5 microns. The Examiner believes that the Applicant is intending to argue that the claim language of "composed of" would exclude the presence of a blend of fibers. According to the MPEP 2111.03, the transitional phrase "composed of" has been interpreted in the same manner as either "consisting of" or "consisting essentially of," depending on the facts of the particular case. The Examiner has interpreted the transitional phrase "composed of" as "consisting essentially of" for the purposes of examination. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." Therefore, the inclusion of other fibers with the glass fibers are considered to be within the scope of the claim until the Applicant clearly indicates what are the basic and novel characteristics of the invention. The rejection is maintained.

In response to Applicant's argument that the flame resistance and permeability as required by claims 26 and 31 are not inherent, the Examiner respectfully argues the contrary. Since the prior art reads on the present claim limitations, it is asserted that the claimed properties must be inherent to the prior product. If said property is not inherent, it is asserted that Applicant's claim must be incomplete. In other words, if Applicant's asserts a lack of inherency in the prior art product, then Applicant's claimed invention is missing an element that is critical



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to the invention, which would patentably distinguish it from the known prior art. The rejection is maintained.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

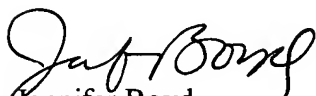
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Boyd  
August 10, 2005



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